

REMARKS/ARGUMENTS

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Double Patenting

Claims 1 to 3 are provisionally rejected on the ground of nonstatutory double patenting rejection as being unpatentable over claim 1 of US Patent 6,669,385. Claim 8 is also provisionally rejected on the ground of nonstatutory double patenting rejection as being unpatentable over claim 1 of US Patent 6,669,385 in view of Morgavi (US Patent 5,558,449). The Applicant herewith submits a terminal disclaimer to overcome the double patenting rejection.

Claim amendment

The Applicant has amended the claims. Claim 1 has been amended to include a plurality of printheads arranged to print ink onto opposing sides of at least one of the media sheets, as recited in claim 8. Accordingly, claim 8 has been limited to having at least two printheads positioned opposite to each other to allow simultaneously printing of ink onto opposing sides of the media sheet as the media sheet passes between the printheads. The Applicant respectfully submits that the amendments to the claim set are fully supported by the originally filed specification.

Claim Rejections – 35 USC § 103

At page 3 of the Office Action, the Examiner rejects claims 1 to 7, and 10 as being unpatentable over Minami (US Patent No. 5,601,389) in view of Kukucka et al (US Patent No. 4,603,971).

Accordingly, claim 1 has been amended to include a plurality of printheads arranged to print ink onto opposing sides of at least one of the media sheets, as recited in claim 8. Claims 2 to 7, and 10 depend on claim 1. Minami and Kukucka et al do not disclose the combination of having a plurality of printheads for printing ink onto opposing sides of a media sheet, as recited in claim 1. Reconsideration and withdrawal of this rejection is respectfully requested.

At page 5 of the Office Action, the Examiner rejects claims 8 and 9 as being unpatentable over Minami (US Patent No. 5,601,389) in view of Kukucka et al (US Patent No. 4,603,971), and further, in view of Morgavi (US Patent No. 5,558,449). Reconsideration and withdrawal of this rejection is respectfully requested in light of the following comments.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In particular, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

On page 5 of the Office, the Examiner states that Minami, as modified by Kukucka et al, teaches all that is claimed in claim 8 except for the use of two opposing printheads to simultaneously print on both sides of the media sheet. The Examiner further states that it would have been obvious to provide a printing and binding device of Minami, as modified by Kukucka et al, with two printheads disposed opposed to each other in order to enable simultaneous double sided printing, as disclosed in Morgavi.

Minami and Kukucka et al both attempt to solve the problem of binding several sheets together. The citations do not disclose or suggest any improvements or modifications aimed at improving printing efficiency, and in particular, the use a plurality of printheads to achieve this. Although Morgavi discloses two printheads disposed opposed to each other to enable simultaneous double sided printing on a passing media sheet, the disclosure in Minami and Kukucka et al is directed at a different problem and does not provide the necessary motivation or suggestion to combine with Morgavi. Accordingly, the Applicant respectfully submits that the first basic requirement of a prima facie case of obviousness has not been met to reject the claims as unpatentable, as per MPEP §2143.

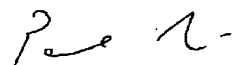
In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

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